

Patent Docket 23FLC31

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: )  
F.L. Conte )  
 ) Art Unit: 3643  
 )  
Application No.: 10/643,288 )  
Confirmation No: 4031 ) Examiner: Rowan, K.  
 )  
Filed: 08/20/2003 )  
  
Title: Duplex Lash Insect Swatter

RECEIVED  
CENTRAL FAX CENTER  
AUG 17 2005

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES****REPLY BRIEF**

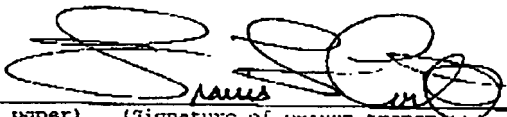
Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR 41.41, and in response to the examiner's Answer dated 27 July 2005, applicant hereby submits this Reply Brief.

**CERTIFICATE OF TRANSMISSION (37 CFR 1.8a and MPEP 512)**

I hereby certify that this 20-PAGE correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office at Fax No. 571-273-8300 on the transmission date indicated below.

FRANCIS L. CONTE  17 August 2005  
(Name of person transmitting paper) (Signature of person transmitting paper) (Date)

## Patent Docket 23FLC31

ARGUMENT

Firstly, the examiner has incorrectly identified applicant's representative on the cover page of the answer: which should be corrected to state "Francis Conte For Appellant."

Suitable correction is therefore requested.

## (7) GROUPING OF CLAIMS

The examiner's three contentions on page 2 of the Answer that "Applicant's brief includes a statement that claims ... stand or fall together ... as set forth in 37 CFR 1.192(c)(7) and (c)(8)" are incorrect.

There are no such statements in the Appeal Brief dated as mailed 3 May 2005.

Indeed, there is no longer any Rule 192 to which the examiner refers in the Answer.

Instead, new part 41 has been added to the Code of Federal Regulations in a final rule having an effective date of 13 September 2004, which has superseded old Rules 192 to 196.

Applicant's main brief was filed under the new rules found in part 41 as specifically identified on the first page thereof. In particular, the main brief has been written to conform with Board Rule 37(c)(1), including (vii) for example, which supersedes the examiner's "Grouping of Claims" contention.

Accordingly, the Board should remand to the examiner, if required, to ensure that the examiner's Answer complies with the new Board Rules, including Rule 39.

On page 3 of the Answer "The examiner drops the rejection of claim 17 under 35 USC 112," it is noted, without further comment by the examiner.

However, Applicant nevertheless requests that the Board now consider that dropped rejection and Applicant's traverse thereof as additional evidence of the examiner's failure to

## Patent Docket 23FLC31

afford due weight to express claim language, which has poisoned all of the other rejections still pending.

Further poisoning the examiner's bases to reject the many claims is the new argument presented for the first time by the examiner in the Answer, beginning at the bottom of page 3.

Patent Rule 104 is fundamental in USPTO practice and is specifically reproduced at page 11 of the main brief.

That rule requires a "through study" by the examiner." That rule mandates that "The examination shall be complete."

And, that rule further requires that "the examiner must cite the best references at his or her command."

The examiner has no doubt thoroughly examined this application under this rule for the first office action dated 07/28/2004, and then again for the final office action dated 12/17/2004; yet in neither office action are found the examiner's present arguments as newly presented in section (11) of the Answer. Why is that?

The answer is simple: Applicant's traverse has merit; yet the examiner does not address that traverse, but, instead, tries to change or supplement or even supplant his previous contentions because the examiner has pre-judged this application and will not allow even one claim.

The examiner now expects the Board of Appeals to overlook this vacillation by the examiner, and overlook the examiner's failure to address or traverse Applicant's rebuttal, and, perhaps affirm the rejections, on what basis then?

MPEP 707.07(f) mandates that "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." This, the examiner has not done.

MPEP 707.07(f) also states that "If it is the examiner's considered opinion that the asserted advantages are not

## Patent Docket 23FLC31

sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages."

Yet, this too, the examiner has not done when many asserted advantages of the duplex insect swatter are expressly presented in the specification, and in the remarks found in the previous responses and main brief.

MPEP 707.07(f) cites case law that "The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable."

The present examiner has clearly not questioned the many asserted advantages of the recited duplex swatter as found in the specification, and as presented in the main brief.

Instead, the examiner simply refers in section (10) to his previous rejections presented in the final office action; and then in the argument section (11) appears to change argument midstream, and tries de novo to belatedly support the rejection of the claims.

Why must Applicant wait until the examiner's Answer for the examiner to present his "thorough" and "complete" and "best" bases for rejection? And, what weight should be afforded to arguments of an examiner, who like a chameleon, changes the color and substance of his arguments to suit his needs to avoid Applicant's traverse?

Note further, that the conferees have further evaluated the merits of this appeal in the appeal conference, have added to the thoroughness of the study and examination, and have now indicated their personal approval by placing their initials on page 6 of the Answer.

What rule or provision permits the examiner to avoid complying with Rule 104, and allows the conferees to condone the belated arguments presented for the first time in the

## Patent Docket 23FLC31

answer, and without reopening prosecution?

The examiner and his conferees now defer (perhaps de novo) to the Board of Appeals to consider the series of arguments presented by the examiner, and leave it to the Board to try to address the sufficiency and inconsistency of those arguments in expectation of affirming the several rejections.

Applicant well recognizes that the Board of Appeals has about a three year backlog of cases. Applicant has gone before the Board twice before in the parent application.

The prosecution of this application, and the parent application, have taken a substantial effort and substantial time, and are a disservice to the public that comes before the USPTO. The rejections of record by the examiner clearly do not have even the color of propriety, as now evidenced by the examiner's apparent disassociation with the previous rejections, and attempt to use the new arguments presented in section (11) of the Answer.

But, that section (11) contains mere examiner argument, devoid of reasoning, and lacking in any evidentiary support.

The examiner contends, quite erroneously, at page 3 of the Answer that "the only difference between Kopp and the present invention as recited in claim 1 is that Kopp shows one rubber band and the present invention recites two."

The main brief well explains the substantial differences between claim 1 and the Kopp reference being applied. For example, claim 1 recites a pair of annular rubber bands in a combination, and Kopp clearly shows a single-strand band of special configuration for the special stock for a special performance having no counterpart in Applicant's claim 1.

Indeed, attached to the main brief is an enlargement of the Kopp device so that there can be no doubt as to its single-strand construction.

The examiner cites "In re Garza" at page 3 of the Answer, but no such case is of record. It may be that the

## Patent Docket 23FLC31

examiner intends to re-apply "In re Harza" as presented in the final office action, but that case has been amply rebutted in the main brief.

Let's assume, however, that Kopp does show a single annular rubber band knotted at one end at staple 4 and again knotted (6) at the opposite end to cooperate with the recess 8 in the piece 7.

The examiner attempts to apply Harza for mere duplication of parts; but the examiner at page 4 of the Answer has not applied Harza on the specific facts thereof, nor has the examiner explained how the holding of Harza would apply to the Kopp device.

The inappropriateness of the Harza case is addressed in the main brief.

Here, however, the examiner simply provides his subjective interpretation for applying Harza for "two rubber bands" in Kopp.

Yet, the examiner's new contentions are pure, unbridled speculation; clearly formed in hindsight to re-fabricate rejections in a rote manner. Note, the previous use of Harza at page 6 of the final office action, and now the new use of Harza in the Answer.

There is no evidence in Kopp that two rubber bands could function; and such two rubber bands would be more complex and more expensive than a single rubber band.

The examiner further speculates that "The two rubber bands would be looped together...." How, and based on what evidence?

Note the special configuration of the single band 5 in Kopp with a knob or knot at the staple 4 and another knob or knot 6 at the recess 8. Why would two (duplicated by Harza) of those special bands 5 be combined in any manner?

The examiner further speculates that the "The user might have two shorter rubber bands that add together in length to that of the original rubber band." Might? Where is the

## Patent Docket 23FLC31

evidence of this?

Suppose the user took those two shorter rubber bands that he might have; and suppose the user cut each annular band to form single strands of double length?

Then suppose the user took each one of those two cut bands, and tied knots in both ends?

Would not then the user have two bands which closely matched the visual configuration of the single-strand band 5 of Kopp, knotted at both ends? The user would then have, not one, but two spare bands 5 which looked like the original band 5.

Yet, that supposition would be more logical than the examiner's attempt to simply combine two shorter annular bands; but such logic is of no value to the examiner because that logic does not lead to applicant's claimed insect swatter.

Suppose, alternatively, that the user had two shorter single strands of plain elastic, the user would then have to further modify those single-strand bands for use in the Kopp gun.

The user would clearly have to tie the two strands together, but how? The user would also have to make a knob or knot at one end for the staple 4, and at the opposite end for the knob or knot 6, but how?

Simply tie knots in the strands? If so, would not those knots simply unravel? In Kopp, the two knobs appear to be fused in order to function as intended, and the examiner has not shown otherwise.

Note that the examiner is not applying Harza for the mere duplication of the two bands 5 in Kopp; but instead the examiner further contends, with the precise guidance of hindsight, that the "user might have two shorter rubber bands," and those "two rubber bands would be looped together...." But how, and where is the evidence of this?

Would the two annular rubber bands be tied together in

## Patent Docket 23FLC31

the middle in the examiner's example?

And, what about the remaining two loop ends? How would the user make knobs or knots therein for attachment at the staple 4 and for reproducing the knob 6 at the recess 8? Would not, for example, the so-made knob 6 be twice as large as in Kopp, and how then would such a large knob 6 even fit in the small recess 8 sized specifically for the single stand band 5 as taught by Kopp?

The "motivation of using two rubber bands ... is merely that ... the rubber band 5 is going to break..." But, this motivation is not the "legal motivation" required by the MPEP and case law, but is hindsight conjecture.

"Going to break," the examiner opines. In that case, would not the user in Kopp merely have at the ready extra ones of the special bands 5 as taught by Kopp? Why should the user be inconvenienced with having to make his own bands for the gun?

The gun in Kopp is expressly a "toy gun" and it is notoriously well known that toys are intended for children, and would a child be so prescient and capable of fabricating a replacement band for the broken band 5?

The examiner further undermines his own contentions at page 4 of the Answer by stating that "a user would have contemplated both a lengthwise connection between the rubber bands and also a side by side connection of the rubber bands along one stock." And, the examiner emphasizes that "Other configurations are also possible."

But, where is the evidence to support this mere examiner argument? Clearly, not in Kopp, nor in Harza.

The examiner's unsubstantiated contentions are clear evidence of the obvious to try standard long ago found unacceptable by the Federal Circuit.

The Federal Circuit stated "At best, in view of these disclosures, one skilled in the art might find it obvious to try various combinations of these known scale and corrosion



## Patent Docket 23FLC31

prevention agents. However, this is not the standard of 35 U.S.C. §103." In re Geiger, 815 F.2d 686, 2 USPQ 1277 (Fed. Cir. 1987), MPEP 2144.06.

The examiner's alternative contentions for lengthwise or side-by-side or other possibilities of multiple rubber bands afford no weight whatsoever to the different construction and function of the bands, and the different cooperation with the special stock in Kopp.

Those contentions are pure examiner speculation, and the examiner, himself, has submitted no evidence in Kopp, or in Harza, or in some other reference, or even in the MPEP in support of those contentions.

At page 5 of the Answer, the examiner's requests from the applicant a "declaration or other evidence to substantiate this point." But, where is the examiner, himself, offering any "declaration or other evidence to substantiate" his pure speculation?

The examiner then adds to the complexity and speculation of his contentions by further stating that the "multiplied effect ... would have a wider area of rubber being sent at the insect which is a multiplied effect." What does this mean, and where is the evidence to support this speculation?

Even a cursory examination of figure 2 of Kopp will show that the examiner's use of two bands 5 connected lengthwise would still have the same knot at the staple 4, and the same knot 6 at the recess 8, but with the addition of another knot in the middle therebetween located closely adjacent to the numeral "5" in figure 2.

Where then is the "wider area" being proffered by the examiner?

The hitting end of the band 5 in figure 2 of Kopp, be that band 5 a single band or two bands end-to-end, remains at the knot 6 at the distal end of the band.

Clearly, there is no "wider area" as the examiner baldly contends.

## Patent Docket 23FLC31

And just as clear, the middle knot proposed by the examiner would have no utility at all in striking the insect illustrated in figure 1 of Kopp; and the examiner has not shown otherwise.

The examiner's proposal to join two rubber bands together requires the formation of the knot 6; but just as clear in this proposal of the examiner is that that knot would necessarily have to be about twice as big as the single knot 6 disclosed in Kopp because that knot 6 would be formed from the double-strand of the band, and not the single strand disclosed in Kopp.

How then would that "wider area" knot 6 proposed by the examiner be held in the small recess 8 found in the Kopp reference? Clearly, it could not be held therein, and would immediately fall therefrom, rendering the toy gun of Kopp inoperable for its intended purpose, by a child or by an adult.

The burden to establish a prima facie case is always on the examiner, and clearly the examiner has failed to establish prima facie rejections of any of the multiple claims reciting different combinations.

And, any contentions proffered by the examiner in rejecting the claims have clearly been rebutted by the Applicant, and found wanting in evidence, wanting in legal support, wanting in support in the MPEP, and wanting even in logic.

At the bottom of page 4 of the Answer, the examiner addresses "hindsight reasoning" by the rote incorporation of standard para. 7.37.03 from MPEP 707.07(f), without even the attempt to apply the fact pattern of the cited McLaughlin case to the facts of the present application.

To the contrary, the examiner has overlooked even the rote holding of this case which expressly states that "But so long as it takes into account only the knowledge which was within the level of ordinary skill."

## Patent Docket 23FLC31

Where is the evidence of such "knowledge" to support any of the examiner's contentions?

The examiner has not cited Kopp for the use of multiple bands for multiple effect.

Harza does not contain evidence of multiple bands for Kopp.

Note the caution in McLaughlin for "only knowledge which was within the level of ordinary skill." The examiner's contentions are clearly being fabricated by the examiner himself in hindsight since the examiner has not provided any evidence of such "only knowledge" to support the requisite modification of Kopp.

At page 5 of the Answer, the examiner now interprets the knot 6 of Kopp as being "considered annular since a loop is formed."

Where is the examiner's evidence of this bald statement?

It is well recognized that typical USPTO practice interprets broadly claim features, but that interpretation must be reasonable and based on one skilled in the art and based on Applicant's written specification.

Where is the "loop" in the knot 6 of Kopp? The examiner has not even attempted to enlarge the knot 6 of Kopp for the benefit of the Board to consider.

Kopp expressly states at column 1, line 42, that the end of the band 5 is "provided with a knob or knot 6." Figures 1 and 2 of Kopp appear to show this knob 6 as a preformed bulb, fused in one mass. If not, the knob will not be retained in the small recess 8.

It is the examiner's duty to provide evidence for what the knob 6 actually is, and the examiner has not provided any evidence that that knob 6 "can be considered annular since a loop is formed."

Even if one were to assume that that knot 6 was formed by tying a knot at the end of the single strand band 5, that knot would still not meet the ordinary definition of annular,

## Patent Docket 23FLC31

or meet the requirement thereof as used in Applicant's specification.

Claim 1 recites a pair of annular bands joined together at a knot therebetween. The band 5 in Kopp is clearly not annular in any definition of the word, and the knot at the distal end thereof does not change that.

Indeed, claim 17 expressly recites "knot-less" loops; yet the examiner has conspicuously overlooked these features.

If the knot 6 in Kopp were formed by the examiner from a single strand, would not that knot unravel? A knot so formed would have to have extensions in both directions due to the tying process, and would not the extension at the distal end interfere with the operation thereof?

If that extension were cut off to duplicate the compact knot 6 disclosed in Kopp, then surely the knot would indeed unravel. This embodiment being proposed by the examiner can surely be evaluated by conducting a simple test of cutting an ordinary rubber band, and then tying a knot in the end thereof.

Another test, would be to take an uncut, simple rubber band as the examiner contends, and attempting to make or tie a knot at one end thereof to replicate the knob 6 of Kopp. That simple test is clearly much more difficult to effect, and will yield a quite large knot 6, with an undesirable double-strand extension. Would that configuration function in the Kopp gun? Clearly not.

The examiner continues to poison the rote rejections of record by not only applying references without regard to the whole thereof, but by failing to consider each claim individually for the different features recited therein.

The examiner has been trapped in his own web, over and over again; and changing argument as the occasion requires.

In the previous example the examiner expressly uses "the knot 6 of Kopp ... [to] be considered annular" for claim 1, but then overlooks the "knot-less" recitation in claim 17.

## Patent Docket 23FLC31

Which interpretation should one of ordinary skill in the art use? Which interpretation should the Board use?

At page 5 of the Answer, the examiner requires the Applicant to prove a negative "in the form of a declaration or other evidence to substantiate this point" of inoperable use of an annular band in Kopp.

The examiner has overlooked the burden of proof here.

The examiner has the burden to establish prima facie obviousness.

The examiner also has the burden to provide evidence to support his contentions and rejections.

It is the examiner himself who proposes to modify Kopp with not only multiple bands 5, but change those multiple bands from single-strand to annular in an attempt to substantiate rejections of the claims.

The Applicant in the main brief has traversed those contentions by the examiner, and the Applicant has no duty to provide evidence to support the negative of the examiner's contentions.

To the contrary, the examiner has the burden to substantiate his own contentions, and to not distort those contentions for creating a new, positive duty for the Applicant.

At page 15 of the main brief, Applicant reproduced the requirements of MPEP 706.02(j), which include:

The MPEP also requires a showing by the examiner of three basic criteria to establish a prima facie rejection including: first, evidence for the suggestion or modification for modifying or combining references; second, a reasonable expectation of success; and finally, the reference(s) must teach or suggest all the claim limitations, and cannot be based on Applicant's own disclosure.

Note, the three express requirements of this mandate, and note, yet again, the failure of the examiner to meet any of those three express requirements.

## Patent Docket 23FLC31

The examiner is always in a position to present mere argument in fabricating rejections, as this examiner has repeatedly done. But, this section of the MPEP and ch. 2100 contain many, many sections of the requirements for prima facie rejections, and the examiner has clearly not met those requirements.

The references applied by the examiner lack similarity to Applicant's recited claims.

The Harza case does not support the examiner, or his proposed modifications of the references.

And, indeed, the present claims are improvement claims, with the parent application having prevailed before two appeals before the USPTO Board of Patent Appeals. Do we disregard this precedent?

At page 5 of the Answer the examiner simply contends without regard to context that "The releasing means of Koop [sic] is the end 13 of the straight portion 12 of the trigger moving upwardly to move the knob 6 of the band 5."

What does this contention relate to? How should the Board evaluate this statement?

Applicant's speculation is that the examiner might be referring to page 33 of the main brief for claim 3.

At page 33 Applicant stated that:

The examiner has failed to show any relevant latch or releasing means in Kopp, and has therefore failed to substantiate this rejection.

Applicant was addressing the rejection of claim 3 as found at page 3 of the final office action wherein the examiner previously stated that "In reference to claim 3, Kopp shows a latch 6 and means 9 for selectively releasing the latch."

It is quite clear that the examiner uses the disparate features of Kopp indiscriminately without regard to their use in Kopp itself, and as serves the examiner best in fabricating rejections, and without regard to inconsistency

## Patent Docket 23FLC31

of that use by the examiner.

Claim 3 introduces two additional elements including the latch 20 and the releasing means 24,20b.

The "latch 6" as used by the examiner at page 3 of the final office action is clearly not a latch, but is the knob or knot 6 of the band 5.

At column 1, lines 46+, Kopp expressly states that:

The releasing means for the end 6 of the band 6 [sic] comprises a trigger made preferably of a single piece of resilient material 9 having one end thereof 10 secured to the under side of the stock 2, the said piece of material being bent preferably at a central portion 11, the portion 12 therebeyond being straight and extending upwardly through the opening 3 in the stock 2, as shown in Fig. 2. The upper end 13 of portion 12 is slightly offset and is brought into bearing relation with the side of the fixed piece 7 and adjacent the recess 8 therein.

Nowhere in the examiner's arguments is any cogent handling of the features of claim 3, leaving for this applicant and the Board to speculate. Why has the examiner done this? To what advantage?

This cursory handling by the examiner of Applicant's claims, and the failure to meet the stringent requirements of the MPEP for each and every claim, and for each and every feature recited therein further poisons the rejections of record.

The knot 6 in Kopp is clearly held in the recess 8 of the fixed piece 7. Kopp could not be any clearer in this teaching.

So, where is the pivotal latch 20 as recited in claim 3 found in Kopp?

Claim 3 further recites the separate releasing means 24,20b for releasing the pivoted latch 20.

The examiner attempts to use the "end 13" of the trigger for the releasing means, without regard to the combination of features recited in claim 3. Why? Why disregard the latch

## Patent Docket 23FLC31

20 also recited in claim 3?

Why has the examiner similarly disregarded other features recited in the many claims of record?

Why has the examiner narrowly construed Applicant's claim 1 at page 3 of the Answer with the "only difference . . .," when this is clearly not the case?

Clearly, Kopp lacks the requisite identity of elements as recited in any of the claims, including claim 3 for which the examiner uses the end 13 out of context.

And, finally, at the bottom of page 5 of the Answer, the examiner again merely repeats verbatim the form para. 7.37.04 as found in MPEP 707.07(f) for suggestion to combine.

This rote application of this section fails to apply the cited cases for the facts thereof; fails to analyze the claims based on the holdings of those cases; and fails to consider the substantial guidance found in ch. 2100 of the MPEP in this very regard.

Note quite conspicuously that the examiner is not relying on the cited cases for "some teaching, suggestion, or motivation to do so [that is combine/modify references] found . . . in the references themselves," and thereby expressly admits that there is no such "teaching, suggestion, or motivation to do so" in the references being applied.

Instead, the examiner must rely on the alternative language in these cases to combine references where "some teaching, suggestion, or motivation to do so [is] found . . . in the knowledge generally available to one of ordinary skill in the art."

Indeed, the examiner further baldly opines that "In this case, the knowledge is generally available to one of ordinary skill in the art." This is nothing more than an verbatim repeat from the form para. 7.34.04; and even fails to comply with that very paragraph itself.

In the Examiner Note for using that para. 7.37.04, the bracket "[1]" entry must be completed by the examiner, and



## Patent Docket 23FLC31

the note requires that "In bracket 1, explain where the motivation for the rejection is found, either in the reference or in the knowledge generally available to one of ordinary skill in the art."

The examiner has clearly not even done this; rendering the various rejections void ab initio.

MPEP 2143.01 and 2143.03 are relevant to this latest bald contention by the examiner.

Both In re Fine and In re Jones now being applied by the examiner in support of his bald contention of "general knowledge" are presented in the MPEP as examples against the very use of that mere contention, and did not support the examiners in those cases, rendering the rejections unsupported.

The Fine case relates to a problem-solving analysis, which the examiner has not conducted in applying Kopp. Kopp has no relevance to Applicant's problems or any problems expressed in any of the other references being applied.

At page 2100-126 of MPEP 2143.01, In re Kotzab (217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000)), is cited by the PTO in which the "Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention."

Where has the present examiner met this test? Where is the evidence to modify Kopp for the various claims recited?

MPEP 2143.01 further cites Al-Site Corp. v. VSI Int'l Inc. (174 F.3d 1308, 50 USPQ2d 1161, (Fed. Cir. 1999) for "The level of skill in the art cannot be relied upon to provide the suggestion to combine references."

This prohibition is exactly what the present examiner has disregarded in the effort to support the rejections based on the simple expedient that "the knowledge is generally available."

## Patent Docket 23FLC31

MPEP 2144.03 at page 2100-132 cites In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), for the proposition that "It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based."

Yet again, this prohibition is exactly what the present examiner has disregarded to support the rejections.

The examiner ends the Answer with the simple summary that "For the above reasons, it is believed that the rejections should be sustained."

Should they? No, to the contrary, all the rejections should be promptly reversed.

The examiner's various contentions are rambling, inconsistent, disjointed, and lack even the color of support under the various references being applied, under the Harza case, and under the various MPEP provisions.

At best, the examiner would have the Board concur with his bald contention that the "only difference between Kopp and the present invention ..." is the use of two bands instead of one rubber band.

This bald interpretation, without any weight being given to Applicant's specification, Applicant's problems presented in that specification, the parent application over which the present invention is an improvement, and without regard to the unexpected and quite surprising results of using annular bands in series for their combined elastic effect as well disclosed in the specification, and so presented in the main brief.

No, the examiner would have the Board take the entirety of Applicant's many claims, and reduce them to a single feature for then rejecting such single-feature claims based on obviousness from ordinary knowledge.

In re Dembiczak cited at page 29 of the main brief is quite relevant. A patent was granted by the USPTO for a

## Patent Docket 23FLC31

simple trash bag colored orange in imitation of a pumpkin and decorative face for Halloween.

What could be any simpler than this pumpkin bag?

Would not such a pumpkin bag also be with the "ordinary knowledge" as used by the present examiner?

It took the U.S. Court of Appeals for the Federal Circuit to explain why such a simple pumpkin bag was not obviousness in reversing the examiner (and Board of Appeals) in that case for hindsight-based rejections without requisite evidence or legal motivation.

Legal motivation is not simply examiner argument in hindsight, as the present examiner has proffered, but much, much more, and ch. 2100 of the MPEP cites case after case in this regard; none of which has the examiner analyzed in supporting his various rejections under the simple expedient of "the knowledge [which] is generally available to one of ordinary skill in the art."

That very last contention made by the examiner at the end of the Answer is reason in and of itself to reverse each and every rejection of record since all rejections are fundamentally based on the unsupported use of Kopp, and the different device disclosed therein.

The examiner's own Answer now provides the Board with further insight in the shortcomings of the arguments being proffered by the present examiner in fabricating the various rejections.

There are now twenty claims of various form, and features, and scope, and the examiner has failed to address those claims one-by-one as required by the MPEP. Instead, the examiner is using various expediciencies to reject the claims en masse, without affording due weight thereto, without due weight to the problems being solved, and without regard to the surprising and unexpected performance advantages in the duplex bands used in all twenty claims.

The single-band devices of the several applied art

## Patent Docket 23FLC31

references are consistent in their use of single bands, with not even a hint or suggestion of any advantage whatsoever in using multiple bands in those devices.

It is only the present examiner, with the full advantage of hindsight, who is fabricating rejections without support in the MPEP or case law; and without suitable evidence.

Examiner argument is never evidence. The final office action and the examiner's Answer are replete with mere examiner argument.

This is because the references of record lack evidence for multiple bands in the form recited in Applicant's claims, in the combinations recited therein, and with the performance and benefits therefrom as well explained in the specification.

Accordingly, all of the rejections of record should be reversed for the reasons presented in both the main brief and this reply brief.

Respectfully submitted,



Francis L. Conte

Date: 17 August 2005

6 Puritan Avenue  
Swampscott, MA 01907  
Tel: 781-592-9077  
Fax: 781-592-4618